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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,651	01/16/2007	Fabrice Madigou	15675P615	3632
8791 7590 01/14/2009 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER				
JONES, MARCUS D				
ART UNIT		PAPER NUMBER		
3714				
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01/14/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/583,651

**Applicant(s)**

MADIGOU ET AL.

**Examiner**

Marcus D. Jones

**Art Unit**

3714

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7-9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed on 13 October 2008 in response to the previous Non-Final Office Action (13 May 2008) is acknowledged and has been entered.

Claims 1-5, 7-9 and 11 are currently pending.

Claims 6 and 10 are cancelled.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. **Claims 1-5, 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Gilboa (US 5,853,327).**

In reference to claims 1 and 8, Gilboa discloses: Electronic game system, characterized in that it comprises: an electronic game platform comprising a central unit (col 9, In 47-49), a memory (col 14, In 40-42), a dynamic display device capable of being placed in essentially horizontal position (col 9, In 41-44, *display screen*), at least one input device for the user (col 10, In 1-15, *inputs received from different elements and in response to moves by the player*), and a means of transmitting information by wireless transmission (col 7, In 37-41 and col 10, In 12-15, *non-line of sight wireless apparatus and game table communicated with processor and other devices, by cable or infrared communication*), and a plurality of pawns that can be moved on the display device (col 3, In 11-13, *figures selectably positionable by a player*), each pawn including a means of receiving information by wireless transmission capable of communication with the said transmission means (col 3, In 39-42), a control means sensitive to the received information (col 19, In 55-63, *Gate device may be connected to processing unit via a connector in game table or wireless communication. Antenna may be used for transmitting command signals to a receiver in the gate device*); and a means of animating the pawns controlled by the control means (col 19, In 56-59), each pawn has its own address for reception of said information (col 4, In 42-46, *discrete frequencies, generated by the different pieces or types of pieces are utilized not only for uniquely identifying pieces but for determining location*).

In reference to claims 2 and 3, Gilboa discloses: characterized in that it also comprises a means of animating the pawn controlled by the control means and characterized in that the animating means comprises a device selected from the group

consisting of light sources, mechanical actuators, sound sources and vibration sources(col 20, ln 32-36).

In reference to claims 4 and 5, Gilboa discloses: characterized in that it also includes a detection means and characterized in that the detection means comprises an apparatus selected from the group consisting of optical sensors, mechanical sensors, electromagnetic sensors, sound sensors and vibration sensors (col 9, ln 13-17).

In reference to claim 9, see above discussion of claims 2 and 3.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilboa (US 5,853,327).**

In reference to claims 7 and 11, Gilboa discloses the invention substantially as claimed. Gilboa further discloses the use of batteries as a power source for the game piece (col 10, ln 29-31). Gilboa does not specifically disclose the use of a rechargeable battery. It would have been a matter of design choice to use rechargeable batteries instead of replaceable batteries. The invention would be expected to perform equally well with any power source appropriate for a game piece. Gilboa also discloses using a resonance circuit as a power source (col 11, ln 22-27).

#### ***Response to Arguments***

6. Amendments to claims 7 and 11 to address the multiple dependent claim issues are noted. The objections are withdrawn.
7. Amendments to claims 3, 5 and 9 to address informalities are noted. The objections are withdrawn.
8. Applicant's arguments have been fully considered but they are not persuasive. With respect to claims 1 and 8, Applicant asserts that, Gilboa does not disclose the amended element, "wherein the element has its own address for reception of said information." The Applicant further asserts that Gilboa game pieces are only moved through direct player interaction does not disclose control by the game.

The Examiner respectfully disagrees.

Gilboa discloses that each game piece uses discrete frequencies to transmit information to and from each game piece (col 4, ln 42-46). The discrete frequency of each game piece ensures that only the intended game piece is accessed. Gilboa also

discloses a solenoid actuator located in a housing connected to the gaming board (see Figure 18C). The solenoid actuator moves a plurality of rods, moving tumblers connected along the rods. When one tumbler hits the bottom of a given game piece, the piece loses its balance and falls down (col 20, ln 8-12). The game piece is moved by the game itself and not only by player interaction.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcus D. Jones whose telephone number is (571)270-3773. The examiner can normally be reached on M-F 9-5 EST, Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John M. Hotaling can be reached on 571-272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marcus D. Jones/  
Examiner, Art Unit 3714

/John M Hotaling II/  
Supervisory Patent Examiner, Art  
Unit 3714